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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/699,465 | 10/31/2003 | Marlon D. Cowart | 6789.US.D1 | 2713 |
| 23492 7590 03/29/2007 ROBERT DEBERARDINE ABBOTT LABORATORIES 100 ABBOTT PARK ROAD DEPT. 377/AP6A ABBOTT PARK, IL 60064-6008 | | | EXAMINER BERNHARDT, EMILY B | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1624 | |
| SHORTENED STATUTORY PERIOD OF RESPONSE | | MAIL DATE | DELIVERY MODE | |
| 3 MONTHS | | 03/29/2007 | PAPER | |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/699,465

Applicant(s)

COWART ET AL.

Examiner

Emily Bernhardt

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 90-102 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 90,91,94,95,98 and 99 is/are rejected.
- 7) ☒ Claim(s) 92,93,96,97 and 100-102 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

The amendment originally filed 10/31/03 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: In the parent history applicants insert the phrase "incorporated herein by reference" in 2 locations. Note MPEP 201.06(c), section IV, p.200-26, October 2005 Edition in which it is stated that said phrasing must be part of the **original** disclosure. A review of the parent file shows no such phrase was present in the disclosure as originally filed and thus needs to be deleted herein since instant case is a DIV of parent case.

Applicant is required to cancel the new matter in the reply to this Office Action.

Applicants should also update the status of parent.

A full copy of the Sule reference previously applied has been obtained and is being provided to applicants. The closest compound therein (namely no.8) was reported to be ineffective as an anthelmintic and thus the rejection is withdrawn since the motivation to further modify said

compound with methyl groups as required herein would not be compelling as originally perceived.

Upon review of commonly assigned patent publications, Cowart (US'878) is noted has a different inventive entity than herein and a US filing date of 6/5/01. The instant claims are all entitled to 119(e) filing date of 12/14/01 but not all claims are entitled to benefit of earlier US provisional filed on 6/5/01 and none of the claims can get benefit of earlier date of 3/9/01. Thus the following rejections are applied.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 90,91,94 and 95 are rejected under 35 U.S.C. 102(e) as being anticipated by Cowart (US'878). Cowart is applied as of its US filing date. Earlier parent date does not contain relevant subject matter except for one pyridyl species excluded within instant scope. See examples 2 and 3 as well as pyridinol species described on p.10 in paragraph [0181].

Claims rejected herein are not fully described in earlier US provisional cases as discussed above. Compare scope at R_F for 90,91 and 94-95 as well as scope at R₁-R₄ for 94-95 which contains alkylsulfonylamino as a choice herein but is not described in earlier US provisional cases.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 98-99 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cowart. The claims rejected herein require that the piperazine ring be substituted on the ring carbons with an alkyl group. While such is not particularly described in Cowart, example 1 in Cowart only differs in having H's in place of an instant methyl group which has been long held is obvious despite an express teaching to modify as stated in the case law previously cited in the Sule rejection. Preparation of methylated products following the teaching of Cowart would be routine since methylated piperazine reactants are readily available from many Chemical Suppliers. Thus it would have been obvious to one skilled in the art at the time the invention was made to expect compounds claimed herein that are methylated on the piperazine

ring to also possess the use taught by the art in view of the close structural similarity outlined above and their preparation to be well within the ordinary skill of the art.

PTO records indicate Cowart has gone abandoned as well as a refiled case.

Claims 92-93,96-97 and 100-102 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 92,93 and 96,97 are entitled to 119(e) priority date of 6/15/01 which makes Cowart a non-competent reference and claims 100-102 which require that a alkylsulfonylamino be present on the pyridine ring is not particularly taught or suggested by Cowart.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emily Bernhardt whose telephone number is 571-272-0664.

If attempts to reach the examiner by telephone are unsuccessful, the acting supervisor for AU 1624, James O. Wilson can be reached at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Emily Bernhardt
Primary Examiner
Art Unit 1624